

REMARKS

Amendments

Claims 1 and 7 are amended to delete references to derivatives and solvates, and claim 7 is amended to delete "the group." Claims 1 and 7 are also amended to refer to mixtures of stereoisomers.

Information Disclosure Statement

In the Office Action issued February 22, 2009, the Examiner argues that the Information Disclosure Statement, filed March 23, 2006, did not comply with 37 CFR 1.98(a)(2). Applicants disagree. Additionally, the Examiner stated that the references "crossed out in the signed copy of the 1449 form have not been considered." However, no such signed copy was attached to the Office Action issued February 22, 2009.

The objection to the Information Disclosure Statement states the requirements of 37 CFR 1.98(a)(2), but fails to indicate how applicants' Information Disclosure Statement did not meet these requirements. The March 23, 2006 Information Disclosure Statement listed 6 references, three PCT publications and three US published applications. Attached to the Information Disclosure Statement was the International Search Report (ISR) issued in corresponding PCT application PCT/EP2004/009743, which listed the three PCT publications and further indicated that the three US published applications corresponded to the three PCT publications.

Additionally, the ISR indicated the relevancy of the three PCT publications. While the International Search Report was in the German language, applicants' Information Disclosure Statement provided a translation of the relevant terms in the ISR. See page 3 of the Information Disclosure Statement.

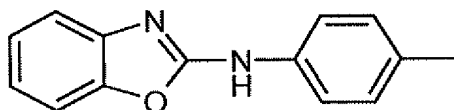
Thus, applicants respectfully submit that the Information Disclosure Statement, filed March 23, 2006, did comply with 37 CFR 1.98(a)(2). Applicants submit herewith further copies of the three PCT publications and another copy of the form PTO/SB/08A ("1449 form"). Applicants request that the Examiner return an initialed copy of the PTO/SB/08A form with the next Office Action.

Restriction Requirement

The Restriction Requirement is again respectively traversed. As noted previously, section (d) of Annex B (Unity of Invention) of the Administrative Instruction under the PCT states that there are three particular situations for determining unity of invention under Rule 13.2, one of these three specific situations being "Markush" practice. Further, section (d) of Annex B makes it clear that the principles set forth in the discussion in sections (e), (f), and (g) are to be understood as an interpretation of the requirements under PCT Rule 13.2.

Section (f) of Annex B states that the requirements for unity under PCT Rule 13.2 for a Markush grouping will be met if the alternatives of the grouping are of "a similar nature." Further, as indicated in section (f)(i), the alternatives will be regarded as fulfilling the criteria of being of a similar nature if the alternatives have a common property/activity and have a common significant structural element (i.e., a common chemical structure which occupies a large portion of their structure).

In the instant case, the compounds share the common activity of modulating signal transduction by kinases. In addition, the compounds exhibit a common significant structural element, namely:



Thus, the claimed Markush grouping satisfies the requirement of section (f) of Annex B and therefore meets the requirements for unity of invention under PCT Rule 13.2.

It is argued in the Office Action that the above structure does not make a contribution over the prior art. However, section (f) of Annex B, which is to be understood as an interpretation of the requirements under PCT Rule 13.2, does not require that the common significant structural element itself make a contribution over the prior art. 37 CFR 1.475 also does not require that the common significant structural element of a Markush claim itself make a contribution over the prior art.

It is further argued in the Office Action that, in response to applicants' arguments regarding 35 USC §121 not permitting restriction within a single claim, that the claims lack unity of invention because the common significant structural element does make a

contribution over the prior art. However, this is not part of the test for whether a Markush group is proper based on the decision in *In re Harnish*, 206 USPQ 300 (CCPA 1980). In *Harnish*, the claimed group of coumarin compounds was held to be a proper because they shared a common core structure and their grouping was not repugnant to scientific classification. As applicants' Markush group meets these same criteria, applicants' claims do not exhibit an improper Markush group and thus restriction within a single claim is impermissible under 35 USC §121. Withdrawal of the Restriction with respect to the compound claims is again respectfully requested.

As for further examination, applicants assume that examination will proceed in accordance with MPEP §803.02. In this regard, applicants note that the Examiner has indicated that the elected species has been found allowable, and that examination was extended to carbon dioxide. However, applicants assert that the interpretation of applicants' claims to read on carbon dioxide is an unreasonable interpretation of the claims when read in light of the specification. Upon reading applicants' disclosure one of ordinary skill in the art would not interpret applicants' claims to read on a naturally occurring compound.

Objection to claims 1-5, 7-11 and 30-38

The objection to claims 1-5, 7-11 and 30-38 as containing non-elected subject matter is traversed for the reasons discussed above with respect to the Restriction Requirement. With respect to claim 7, this claim now uses the format "selected from A, B, C, and D." It is respectfully submitted that this format is acceptable. Withdrawal of the objection is respectfully requested.

Rejection under 35 U.S.C. §112, first paragraph

Claims 1-5, 7-11 and 30-38 are rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking written description. This rejection is respectfully traversed.

While applicants disagree with the assertion that the recitation of "derivatives" lacks written description, to facilitate prosecution applicants have amended the claims to delete derivatives. Withdrawal of the rejection is respectfully requested.

With respect to "mixtures thereof," this language itself provides more than sufficient written description to one of ordinary skill in the art. One of ordinary skill in the art readily

understands the concept of mixtures. Further, if one has two separate components, one can readily mix these two components in any desired ratio. Thus, one of ordinary skill in the art can readily envision mixtures in any desired ratio.

In view of the above remarks, it is respectfully submitted that applicants' original disclosure reasonably conveys possession of the claimed subject matter to one of ordinary skill in the art. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. §112, first paragraph

Claims 1-5, 7-11 and 30-38 are rejected under 35 U.S.C. §112, first paragraph, as allegedly being non-enabled. This rejection is respectfully traversed.

Applicants disagree that "solvates" and "derivatives," as reasonably interpreted in light of the specification, lack enablement in light of applicants' disclosure. However, in order to facilitate prosecution, applicants have amended the claims to delete references to "solvates" and "derivatives." Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. §112, second paragraph

Claims 1-5, 7-11 and 30-38 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

It is common knowledge in the chemical art the compounds can exist as mixtures of isomers. For example, one of ordinary skill in the art would readily recognize that compounds which exhibit a single chiral atom can exist as two enantiomers. Further, one skilled in the art would recognize that such a compound can exist as a racemic mixture, i.e., a 50:50 mixture of the two enantiomers.

Thus, one of ordinary skill in the art can readily understand the subject matter of applicants' claims. In particular, one of ordinary skill in the art can readily recognize whether a given embodiment is within or outside the literal scope of the claims. Nothing more is required under the statute. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. §102(b)

Claims 1-7 and 30-38 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated in view of the paper by Reckhow. This rejection is respectfully traversed.

This rejection is based upon the Examiner's expansive definition of derivatives. In general, the Examiner says "derivatives" encompasses carbon dioxide and thus the claims are all rejected in view of carbon dioxide. As noted above, applicants disagree that this is a reasonable interpretation of applicants' claims when read in light of the specification.

In any event, applicants' claims are amended to delete the recitation of "derivatives" from the claims. Withdrawal of the rejection is respectfully requested.

Obviousness-type Double Patenting Rejection in view of Serial No. 12/328,320

Claims 1-5, 7, 9, 10 and 30-38 are rejected on grounds of obviousness-type double patenting in view of claims 1-3, 5-6, 8-9, and 11 U.S. Serial No. 12/328,320.

In response to this provisional rejection, applicants will submit a Terminal Disclaimer with respect to Serial No. 12/328,320. Submission of the Terminal Disclaimer is not to be construed as acquiescence to any ground of rejection. Withdrawal of the rejection is respectfully requested.

Obviousness-type Double Patenting Rejection in view of US 7,470,702

Claims 1-5, 7, 9, 10 and 30-38 are rejected on grounds of obviousness-type double patenting in view of U.S. Patent No. 7,470,702. (Assignment 017848/0210)

Applicants submit herewith a Terminal Disclaimer with respect to U.S. Patent No. 7,470,702. Submission of the Terminal Disclaimer is not to be construed as acquiescence to any ground of rejection. Withdrawal of the rejection is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Brion P. Heaney/

Brion P. Heaney, Reg. No. 32,542
Attorney for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Boulevard, Suite 1400
Arlington, VA 22201
Direct Dial: 703-812-5308
Facsimile: 703-243-6410
Attorney Docket No.:MERCK-3155

Date: July 20, 2009